

REMARKS

In regard to the objection to the disclosure, the disclosure has been amended above to correct a typographical error.

In regard to the rejection of claim 15, 26 and 37 under 35 U.S.C. 112, first paragraph, the examiner is requested to reconsider his rejection. A portion of the description has been amended above to clarify the language used in the claims. A person skilled in the art would clearly have understood that the way "the **flexible** mounting tails 13 ensure that the solder joints between the mounting tails 13 and the PCB 5 are not over-stressed" is by the **flexible** mounting tails 13 providing a flexible connection.

MPEP 2163 states that "To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." MPEP 2163 also states that "...there is no *in haec verba* requirement...".

In the present case, the description as originally filed, including the description "the **flexible** mounting tails 13 ensure that the solder joints between the mounting tails 13 and the PCB 5 are not over-stressed" clearly fulfills the written description requirement for the language in the claims "...said mounting tails are configured to be flexible to thereby provide a flexible connection of the shielding cage to the circuit board by the mounting tails...". The examiner is requested to withdraw his rejection based upon 35 U.S.C. 112, first paragraph.

Claims 15-20, 25-31, 36 and 37 were rejected under 35 U.S.C. §102(b) as being anticipated by Cunningham (US 6,351,394 B1). Claims 15-37 were rejected under 35 U.S.C. §103(a) as being unpatentable over Benzoni (US 5,416,668) in view of Applicant Admitted Prior Art (AAPA). The examiner is requested to reconsider these rejections.

In regard to the rejection under 35 U.S.C. 102(b), the examiner relies upon Fredman V. Harris-Hub Company, Inc., 163 USPQ 397 (DC NII 1969) for apparently ignoring the words "flexible" in the claims. In Fredman V. Harris-Hub Company, although the Court stated that "The Court finds that the words "flexibility" or "rigidity" are relative terms, particularly since virtually anything will flex if enough pressure is applied to it.", the Court stated that:

"Claim 4 is not infringed if the end portions of the accused rails do not flex, i.e., if such end portions are not "capable of being resiliently laterally deflected" as recited in Claim 4.", and

"The Court finds that the Harris-Hub rails do not meet the first requirement of Claim 4 in that such rails are not designed to flex at their end portions and are not capable of being resiliently laterally deflected."

When discussing the words "flexibility" or "rigidity" as being relative terms, the court was **distinguishing those words** from words such as "flex" and "resiliently laterally deflected". The claims of the present application do not contain the words "flexibility" or "rigidity", so the examiner's reliance on Fredman V. Harris-Hub Company, Inc. is misplaced. Claim 15

for example claims "wherein said mounting tails are configured to be **flexible** to thereby provide a **flexible connection** of the shielding cage to the circuit board by the mounting tails". There is no mention of the word "flexibility" in claim 15. The examiner is committing error in relying on Fredman V. Harris-Hub Company, Inc. as justification for failing to give the words "flexible" patentable weight in the claims.

Nowhere in Cunningham is there a disclosure or suggestion of a shielding cage which is a die-cast member having mounting tails configured to be flexible to thereby provide a flexible connection of the shielding cage to a circuit board by the mounting tails. Merely because Cunningham discloses that pins 20 are made of metal, this is not a disclosure that pins 20 are flexible or provide a flexible connection.

The examiner is directed to MPEP 2131. Anticipation requires that **each and every element** of the claimed invention be disclosed in a single prior art reference (emphasis added). In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Anticipation requires **identity** of the claimed invention (emphasis added). Tyler Refrigeration v. Kysor Indus. Corp., 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985). For anticipation, there must be **no difference** between the claimed invention and the reference disclosure (emphasis added). Scripps Clinic & Res. Found. V. Genentech, Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991). The corollary of the rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

In the present case, the examiner has not proven that there is **identity** between the cited references and the features of claim 15. In the present case, the examiner has not proven that **each and every element** of the claimed invention is disclosed in the cited reference. In the present case, the examiner has not proven that there are **no differences** between the claimed invention and the reference disclosure. The cited reference does not "anticipate" claim 15.

Nor are the features of claim 15 obvious in view of Cunningham, either alone or in combination with the other art of record. Nowhere in the art of record is there a suggestion of a shielding cage which is a die-cast member having mounting tails configured to be flexible to thereby provide a flexible connection of the shielding cage to a circuit board by the mounting tails.

Benzoni merely discloses that the housing 20 comprises a molded non-conductive member; such as molded plateable engineering grade plastic (column 2, lines 26-27 and 38-40). Surfaces of the housing 20 are plated with an electrically conductive material, such as copper (column 3, lines 29-31). There is no disclosure or suggestion in Benzoni or AAPA of flexible mounting tails on a die cast shielding cage. Any statement to the contrary is clearly based upon hindsight after reading applicants' patent application. Mounting post 62 are described as being made of nonconductive material (see column 2, lines 26-27 and lines 65-66). 90 and 100 are alternate types of mounting posts, but there is no disclosure or suggestion of them being metal; merely molded non-

conductive member plated with metal, and there is no suggestion to make 20, 62, 90 or 100 from die-cast metal.

The examiner has stated that it would be obvious to modify the walls, shielding cage and mounting tails of Benzoni by employing die cast process for intended use. However the examiner has not explained why it would have been obvious to modify the walls, shielding cage and mounting tails of Benzoni by employing die cast process. The examiner has merely stated a conclusion; not a reason for that conclusion. As noted in MPEP 2142 "The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). In the present case the examiner has merely made a conclusory statements instead of an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. The examiner has not provided evidence (as required by MPEP 2142) which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. Thus, the examiner has not established a *prima facie* case of obviousness.

The features of claim 15 are not disclosed or suggested in the cited art. Therefore, claim 15 is patentable and should be allowed.

Though the claims dependent upon claim 15 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 15.

However, to expedite prosecution at this time, no further comment will be made.

Claim 26 claims that the mounting tails are configured to be flexible to provide a flexible connection between the shielding cage and the circuit board, wherein the flexible connection is adapted to provide relief of shear stress developing as a result of the difference of thermal expansion coefficient between the circuit board and the shielding cage.

Nowhere in Cunningham is there a disclosure or suggestion of the pins/projections 20, 22 being configured to be flexible to provide a flexible connection between the frame 10 and a circuit board. Thus, Cunningham does not "anticipate" the features of claim 26.

Nor are the features of claim 26 obvious in view of Cunningham, either alone or in combination with the other art of record. Nowhere in the art of record is there a suggestion of mounting tails are configured to be flexible to provide a flexible connection between the shielding cage and the circuit board, wherein the flexible connection is adapted to provide relief of shear stress developing as a result of the difference of thermal expansion coefficient between the circuit board and the shielding cage as recited in claim 26.

As noted above, Benzoni merely discloses that the housing 20 comprises a molded non-conductive member; such as molded plateable engineering grade plastic (column 2, lines 26-27 and 38-40). Surfaces of the housing 20 are plated with an electrically conductive material, such as copper (column 3, lines 29-31). There is no disclosure or suggestion in Benzoni

or AAPA of flexible mounting tails on a die cast shielding cage. Any statement to the contrary is clearly based upon hindsight after reading applicants' patent application.

The examiner has stated that it would be obvious to modify the walls, shielding cage and mounting tails of Benzoni by employing die cast process for intended use. However the examiner has not explained why it would have been obvious to modify the walls, shielding cage and mounting tails of Benzoni by employing die cast process. The examiner has merely stated a conclusion; not a reason for that conclusion.

The features of claim 26 are not disclosed or suggested in the cited art. Therefore, claim 26 is patentable and should be allowed.

Though the claims dependent upon claim 26 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 26. However, to expedite prosecution at this time, no further comment will be made.

Claim 37 claims that the flexible mounting tails are configured to provide a flexible connection between the shielding cage and the circuit board. There is no disclosure or suggestion in Cunningham that the pins/projections 20, 22 are configured to provide a flexible connection between the frame 10 and a circuit board. There is no disclosure or suggestion in Benzoni or AAPA of flexible mounting tails of a die cast member which are configured to provide a flexible connection between a shielding cage and a circuit board.

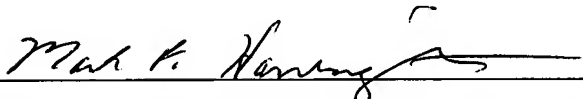
Appl. No.: 10/539,914

The examiner has stated that it would be obvious to modify the walls, shielding cage and mounting tails of Benzoni by employing die cast process for intended use. However the examiner has not explained why it would have been obvious to modify the walls, shielding cage and mounting tails of Benzoni by employing die cast process. The examiner has merely stated a conclusion; not a reason for that conclusion.

The cited art of record does not disclose or suggest the features recited in claim 37. Therefore, claim 37 is patentable and should be allowed.

Favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

Respectfully submitted,

  
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2/4/09  
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